

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

REQUEST FOR RECONSIDERATION		ATTORNEY DOCKET NO. 70014.0018USI2	
		U.S. APPLICATION SERIAL NO. 10/050,994	CONFIRMATION NO 2175
		FILING DATE January 22, 2002	
INVENTOR(S) Jim HUNTER, et al.	EXAMINER Alessandro V. AMARI	GROUP ART UNIT 2872	
TITLE OF APPLICATION HIGH CONTRAST GRATING LIGHT VALVE			

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Responsive to the outstanding office action issued in the above-mentioned captioned matter on November 2, 2005, the time for response thereto being extended by virtue of the Petition and extension fees submitted herewith, withdrawal of the rejection of all claims over U.S. Patent 6,233,087, Hawkins et al. (Hawkins) is respectfully requested, as the reference is not prior art to Applicants. The reference is cited as prior art under 35 USC §102(e). The effective date of the reference is December 18, 1998.

Applicants have previously submitted declarations, backed by contemporaneous documents, that demonstrate, and specifically state, that the device of the subject matter of the claims was made by the inventors, that is, reduced to practice prior to December, 1998, and tested and demonstrated to work for its intended purpose, in that it effectively modulated light. More is not required to establish prior invention, pursuant to 37 CFR §1.131.

The Rejection is Traversed

Much of the discussion in the outstanding rejection has to do with conception and diligence. Respectfully, those are simply not an issue here. Applicants have submitted,

by way of a Declaration under 37 CFR §1.131, that they actually made the product claimed, and tested it, prior to the effective date of the reference. Such a showing is sufficient to overcome the rejection, 37 CFR §1.131. Pursuant to the Rule, photocopies of original exhibits must accompany and form part of the declaration, “or their absence must be satisfactorily explained.” As far as Applicants can tell, since the Declaration contains the express representation of the inventors that in fact the subject matter was made and tested, the sole point of objection is the absence of test results, in documentary form, confirming the invention tested out well. Applicants note, for example, that they did in fact provide step-by-step contemporaneous documents which show precisely how the device was made. Applicants even provided a step-by-step equivalence chart, to show how each step in the process reflected in the contemporaneous documents corresponds to a feature of the claims. See Exhibit B of the declarations already of record, including those dated July 25, 2005.

There is no requirement that actual test data showing the invention performed in the way it was intended accompany the declaration. In the particular case, although the test was performed, and the inventors and corroborators recall it being performed, in fact, the reports of that testing, some eight years old, are simply not in evidence. Subsequent tests of the same type of device, showing the same sort of results, have been identified and will be provided in a supplemental submission, to demonstrate both the type of testing that was conducted, and the basis for Applicants’ conclusion that in fact the device worked. But the least important of the elements in question, the actual test document reflecting modulation of light, is simply not in the files held by Applicants. In this respect, it is noted that the invention was originally reduced to practice before Silicon

Light Machine became a part of Cypress Semiconductor and files and documentation, such as that incorrectly asserted by the Examiner to be a requirement of practice, have simply been lost. This is hardly surprising.

The Examiner offers no reason why the express statement of the inventors that the invention was tested, and shown to modulate light, is unbelievable, or unacceptable in any way. What documents do exist from that time frame, that show precisely how the device was fabricated, have been advanced to the Patent Office. Indeed, it is not certain how the Examiner comes by the position that the device so fabricated will not work. It is the Examiner's position that such devices do in fact work, based at least on the disclosure of Hawkins.

Accordingly, should the Examiner persist in the rejection over Hawkins, the Examiner is invited to identify that portion of the Rule that insists, even where documentary evidence has been lost, that it must be supplied, or the rejection cannot be removed. The Examiner is also respectfully requested to indicate how the Examiner comes to the conclusion that the device so constructed would not work, since a device constructed along these lines would be expected by those of ordinary skill in the art to work.

In short, the device was made. The Declaration of the inventors, accompanied by contemporaneous, demonstrates its operation. The device was tested. The Declarants so state. The device worked for its intended purpose. The Declarants so state. And one of ordinary skill in the art, told that the device was made in this fashion, would have

expected it to modulate light. There is no enablement rejection outstanding.

Accordingly, the rejection over Hawkins is respectfully traversed.

The Examiner's objection to the correction of inventorship is unclear. An oath or declaration by each actual inventor is of record. If the Examiner can identify that inventor or inventors missing, the Examiner is respectfully requested to identify the same.

All claims pending being directed to subject matter invented before the effective date of the reference, independent of the teaching of that reference, withdrawal of the rejection is respectfully requested.

Given the withdrawal of the rejection over Godil and the allowability of the claims presented, a favorable action is respectfully requested.

Respectfully submitted,

MERCHANT & GOULD P.C.



Steven B. Kelber
Registration No. 30,073

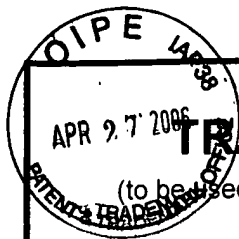
April 27, 2006

Date

P.O. Box 2903
Minneapolis, Minnesota 55402-0903
Telephone No. (202) 326-0300
Facsimile No. (202) 326-0778

23552

Patent & Trademark Office



TRANSMITTAL FORM

(to be used on all correspondence after initial filing)

ATTORNEY DOCKET NO.

70014.0018US12

U.S. APPLICATION SERIAL NO.

10/050,994

CONFIRMATION NO.

2175

FILING DATE

January 22, 2002

INVENTOR(S)

Jim HUNTER, et al.

EXAMINER

Alessandro V. AMARI

GROUP ART UNIT

2872

TITLE OF APPLICATION

HIGH CONTRAST GRATING LIGHT VALVE

ADDRESS TO:

**Mailstop Amendment
Commissioner for Patents
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450**

ENCLOSURES

- ☒ Transmittal Form
- ☒ Fee Transmittal (In Duplicate)
- ☒ Request for Extension of Time (3 Months)
- ☒ Request for Reconsideration
- ☒ Return Postcard

☒ Please charge Deposit Account No. 13-2725 in the amount of \$1,020.00 to cover any required fees. In the event any variance exists between this amount and the Patent Office charges for filing the above-noted documents, including any fees required under 35 CFR 1.136 for any necessary extension of time to make the filing of the attached documents timely, please charge or credit the difference to Deposit Account No. 13-2725. Further, if these papers are not considered timely filed, then a request is hereby made under 37 CFR 1.136 for the necessary extension of time.

CORRESPONDENCE ADDRESS

☒ The address associated with Customer Number: **23552** OR ☐ the correspondence address below.

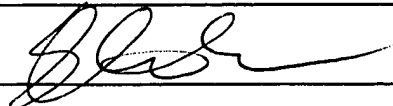
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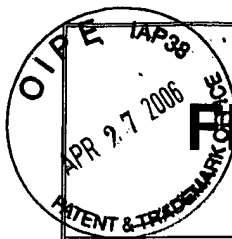
Address

City

State

Zip Code

NAME	Steven B. Kelber	REGISTRATION NO.	30,073
SIGNATURE		DATE	April 27, 2006
NAME		TELEPHONE	202 326-0300
		REGISTRATION NO.	



FEE TRANSMITTAL

ATTORNEY DOCKET NO.

70014.0018US12

U.S. APPLICATION SERIAL NO.

10/050,994

CONFIRMATION NO.

2175

FILING DATE

January 22, 2002

INVENTOR(S)

Jim HUNTER, et al.

EXAMINER

**Alessandro V.
AMARI**

GROUP ART UNIT

2872

TITLE OF APPLICATION

HIGH CONTRAST GRATING LIGHT VALVEApplicant claims small entity status. See 37 CFR 1.27.
Certain fees are reduced by 1/2.

TOTAL AMOUNT OF PAYMENT

\$1,020.00

☒ Please charge Deposit Account No. 13-2725 in the amount of \$1,020.00 to cover any required fees. In the event any variance exists between this amount and the Patent Office charges for filing the documents noted below, including any fees required under 37 CFR 1.136 for any necessary extension of time to make the filing of the attached documents timely, please charge or credit the difference to Deposit Account No. 13-2725. Further, if these papers are not considered timely filed, then a request is hereby made under 37 CFR 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed for fee processing.

The following fees have been submitted:

APPLICATION FEES

	FEE CODE	DESCRIPTION	FEE	CALCULATE
<input type="checkbox"/>	1011	Basic Filing Fee - Utility	\$300.00	
<input type="checkbox"/>	1111	Utility Search Fee	\$500.00	
<input type="checkbox"/>	1311	Utility Examination Fee	\$200.00	
<input type="checkbox"/>	1012	Basic Filing Fee - Design	\$200.00	
<input type="checkbox"/>	1112	Design Search Fee	\$100.00	
<input type="checkbox"/>	1312	Design Examination Fee	\$130.00	
<input type="checkbox"/>	1005	Provisional Application Filing Fee	\$200.00	
<input type="checkbox"/>	1014	Basic Filing Fee - Reissue	\$300.00	
<input type="checkbox"/>	1051	Surcharge - Late Filing Fee, Search Fee, Examination Fee or Oath or Dec.	\$130.00	
<input type="checkbox"/>	1801	Request for Continued Examination	\$790.00	
<input type="checkbox"/>	1814	Terminal Disclaimer	\$130.00	
<input type="checkbox"/>	1452	Petition to Revive Unavoidably Abandoned Application	\$500.00	
<input type="checkbox"/>	1453	Petition to Revive Unintentionally Abandoned Application	\$1,500.00	
SUB TOTAL			\$ 0.00	

EXTENSION OF TIME FEES

	FEE CODE	DESCRIPTION	FEE	SUBMITTED
<input type="checkbox"/>	1251	Extension for Response Within the First Month	\$120.00	
<input type="checkbox"/>	1252	Extension for Response Within the Second Month	\$450.00	
<input checked="" type="checkbox"/>	1253	Extension for Response Within the Third Month	\$1,020.00	\$1,020.00
<input type="checkbox"/>	1254	Extension for Response Within the Fourth Month	\$1,590.00	
<input type="checkbox"/>	1255	Extension for Response Within the Fifth Month	\$2,160.00	
Credit for Extensions Previously Paid				
SUB TOTAL			\$1,020.00	

APPLICATION SIZE FEES

<input type="checkbox"/> Additional Fee for specification and drawings filed in paper over 100 sheets (excluding sequence listing in compliance with 37 CFR 1.821(c) or (e) or computer program listing in an electronic medium) (37 CFR 1.492(j)). The fee is \$250 for each additional 50 sheets or fraction thereof.				\$0.00
Total Sheets	Extra Sheets	Number of each additional 50 sheets or fraction thereof (round up to whole no.)	RATE	
0-100	/50=		x \$250.00 =	

DOCKET NO. 70014.0018US12	APR 27 2006 0/050,994	APPLICATION SERIAL NO. 0/050,994	FILING DATE January 22, 2002
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CLAIM FEES

CLAIMS	NUMBER FILED	NUMBER PREV. PAID FOR	MAX. PAID	NUMBER OF ADD'L CLAIMS	RATE		
Total Claims	0	<input checked="" type="checkbox"/>	20		x \$50	\$0.00	\$0.00
Independent Claims	0	<input checked="" type="checkbox"/>	3		x \$200	\$0.00	
<input type="checkbox"/> MULTIPLE DEPENDENT CLAIM(S)					+ \$360	\$0.00	
TOTAL OF ABOVE CALCULATIONS =							

APPEALS/INTERFERENCE FEES

	FEE CODE	DESCRIPTION	FEE	SUBMITTED
<input type="checkbox"/>	1401	Notice of Appeal	\$500.00	
<input type="checkbox"/>	1402	Filing a Brief in Support of an Appeal	\$500.00	
<input type="checkbox"/>	1403	Request for oral Hearing	\$1,000.00	
SUB TOTAL			\$ 0.00	

POST-ALLOWANCE FEES

	FEE CODE	DESCRIPTION	FEE	SUBMITTED
<input type="checkbox"/>	1501/1511	Utility/Reissue Issue Fee	\$1,400.00	
<input type="checkbox"/>	1502	Design Issue Fee	\$800.00	
<input type="checkbox"/>	1503	Plant Issue Fee	\$1,100.00	
SUB TOTAL			\$ 0.00	

TOTAL OF FEES SUBJECT TO REDUCTION FOR SMALL ENTITY STATUS			\$1,020.00
<input type="checkbox"/>	Applicant claims small entity status. See 37 CFR 1.27. Fees above are reduced by 1/2.		x 1.00= \$1,020.00

FEES NOT SUBJECT TO REDUCTION FOR SMALL ENTITY STATUS

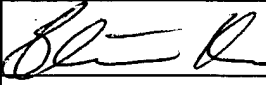
POST-ISSUANCE FEES

	FEE CODE	DESCRIPTION	FEE	SUBMITTED
<input type="checkbox"/>	1811	Certificate of Correction	\$100.00	
<input type="checkbox"/>	1812	Request for Ex Parte Reexamination	\$2,520.00	
<input type="checkbox"/>	1813	Request for Inter Partes Reexamination	\$8,800.00	
SUB TOTAL			\$ 0.00	

MISCELLANEOUS FEES

	FEE CODE	DESCRIPTION	FEE	SUBMITTED
<input type="checkbox"/>	1053	Non-English Specification	\$130.00	
<input type="checkbox"/>	1806	Submission of an Information Disclosure Statement	\$180.00	
<input type="checkbox"/>	8001	Printed Copy of Patent <u>0</u> copies x	\$3.00	
<input type="checkbox"/>	8021	Recording Assignment, Agreement or Other Paper <u>0</u> properties x	\$40.00	
<input type="checkbox"/>	1504/1505	Publication/Republication Fee	\$300.00	
SUB TOTAL			\$ 0.00	

TOTAL FEES SUBMITTED	\$1,020.00
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NAME	Steven B. Kelber	REGISTRATION NO.	30,073
SIGNATURE		DATE	April 27, 2006
NAME		REGISTRATION NO.	